



Application No. 788,096
Filing Date: 02/20/2001

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2875-

First named inventor: Steven M. Maine
Examiner: Husar, Stephen F.
Art Unit: 2875

Date Mailed: 01/06/2004

Ref: Claim Rejections
Reply to office action of 11/13/2003

Remarks / Arguments

1. Both WO 00/05038 and CHUNG (6,511,199) have tool holders that are designed to provide illumination along the same axis as the tool and therefore are unable to provide illumination to the tool tip. Illumination is only provided along the side of the tool and does not intersect the tool tip creating a shadowed area on tool tip.
2. Both WO 00/05038 and CHUNG (6,511,199) have tool holders that are designed to pivotally rotate the tool from storage in the handle to the illumination point which is in the same axis as the tool. The pivotal rotation system is illuminated when it is in the down locked position in the same axis as the illumination source.
3. Both WO and CHUNG are overcome by a light source that is positioned at an acute angle, to the axis of the instrument secured. Illumination is provided to the tip of the tool not along the side of the tool providing a non-shadow illumination to both the tool tip and working area.
4. Both WO and CHUNG are overcome by a 15-60 degree tool positioning that provides illumination at an acute angle, to the axis of the instrument secured.
5. Direct all correspondence to:

David Jacobsen Phone: 208 337-3869
744 Audrey
Homedale, ID 83628

6. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "S. M. Maine".

Date 01/06/2004

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Office Action Summary

Application No.	Applicant(s)
09/788,096	MAINE, STEVEN M.
Examiner	Art Unit
Stephen F. Husar	2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 4-9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e). prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 4-9 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/05038. RE claim 4, Figs. 2 and 5 show an illuminated tool holder having a light source "34" to illuminate the tips of a plurality of instruments "21" which are pivotally nested in a hand grip "10". RE claim 5, see light switch "31". Re claims 6 and 7, note in Figs.2 and 5 that grip "10" has multiple tools "21", which pivotally rotate to provide the recited 15 to 60 degrees of positioning. Re claims 8 and 9, note that the grip "10" is sized to ergonomically rest in the left or right hand of the user.

3. Claims 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by CHUNG (6,511,199). RE claim 4, Figs. 2 and 5 show an illuminated tool holder having a light source "34" to illuminate the tips of a plurality of instruments "21" which are pivotally nested in a hand grip "10". RE claim 5, see light switch "31". Re claims 6 and 7, note in Figs.2 and 5 that grip "10" has multiple tools "21", which pivotally rotate to provide the recited 15 to 60 degrees of positioning. Re claims 8 and 9, note that the grip "10" is sized to ergonomically rest in the left or right hand of the user.

Response to Arguments

4. Applicant's arguments with respect to claims 4-9 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Husar whose telephone number is 703-308-1932. The examiner can normally be reached on Monday-Friday from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Stephen F. Husar
Stephen F. Husar
Primary Examiner
Art Unit 2875

SFH

David Jacobsen
744 Audrey
Homedale, ID 83669-
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Commissioner for Patents
Stephen F. Hussar - Art Unit 2875
P.O. Box 1450
Alexandria, VA 22313
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